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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,108	08/26/2003	Pramod B. Mahajan	1264D	9415

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EXAMINER

PAK, YONG D

ART UNIT PAPER NUMBER

1652

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,108

Applicant(s)

MAHAJAN, PRAMOD B.

Examiner

Yong D. Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 and 8 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

5-00

DETAILED ACTION

This application is a divisional of 09/835,654, now issued as U.S. Patent No. 6,646,182.

The amendment filed on March 23, 2005, amending claim 1 and the specification and canceling claim 7, has been entered.

Claims 1-6 and 8 are pending. Claims 1-6 and 8 are under consideration.

Response to Arguments

Applicant's amendment and arguments filed on March 23, 2005, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claim Objections

Claim 2 is objected to because of the following informalities: the claims recite the phrase "wherein said sequence encodes a polypeptide having 3' to 5' exonuclease activity". It appears that applicants have meant to recite "wherein said protein has 3' to 5' exonuclease activity". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a polypeptide with SEQ ID NO:2 having exonuclease activity, does not reasonably provide enablement for any polypeptide comprising 90 consecutive amino acids of the exonuclease of SEQ ID NO:2 or any polypeptide having 80-95% sequence identity to the exonuclease of SEQ ID NO:2. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Factors to be considered in determining whether undue experimentation is required, are summarized in *In re Wands* (858 F.2d 731, 8 USPQ 2nd 1400 (Fed. Cir. 1988)) as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claim(s).

Claim 1 is drawn to any exonuclease comprising 90 consecutive amino acids of the exonuclease of SEQ ID NO:2. Claims 2-5 are drawn to any exonuclease having 80-95% sequence identity to the exonuclease of SEQ ID NO:2. The scope of the claims is not commensurate with the enablement provided by the disclosure with regard to the extremely large number of exonucleases broadly encompassed by the claims. Since

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the amino acid sequence of a protein determines its structural and functional properties, predictability of which changes can be tolerated in a protein's amino acid sequence and obtain the desired activity requires a knowledge of and guidance with regard to which amino acids in the protein's sequence, if any, are tolerant of modification and which are conserved (i.e. expectedly intolerant to modification), and detailed knowledge of the ways in which the proteins' structure relates to its function. However, in this case the disclosure is limited to the nucleotide and encoded amino acid sequence of only one exonuclease. It would require undue experimentation of the skilled artisan to make and use the claimed polypeptides. The specification is limited to teaching the use of SEQ ID NO: 2 as an exonuclease but provides no guidance with regard to the making of variants and mutants or with regard to other uses. In view of the great breadth of the claim, amount of experimentation required to make the claimed polypeptides, the lack of guidance, working examples, and unpredictability of the art in predicting function from a polypeptide primary structure, the claimed invention would require undue experimentation. As such, the specification fails to teach one of ordinary skill how to use the full scope of the polypeptides encompassed by this claim.

While enzyme isolation techniques, recombinant and mutagenesis techniques are known, and it is routine in the art to screen for multiple substitutions or multiple modifications as encompassed by the instant claims, the specific amino acid positions within a protein's sequence where amino acid modifications can be made with a reasonable expectation of success in obtaining the desired activity/utility are limited in any protein and the result of such modifications is unpredictable. In addition, one skilled

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in the art would expect any tolerance to modification for a given protein to diminish with each further and additional modification, e.g. multiple substitutions.

The specification does not support the broad scope of the claims which encompass all modifications and fragments of any exonuclease having at least 90 consecutive amino acids of the exonuclease of SEQ ID NO:2 or any exonuclease having at least 80-95% identity to the exonuclease of SEQ ID NO:2 because the specification does not establish: (A) regions of the protein structure which may be modified without affecting exonuclease activity; (B) the general tolerance of exonucleases to modification and extent of such tolerance; (C) a rational and predictable scheme for modifying any amino acid residue on the polypeptide with an expectation of obtaining the desired biological function; and (D) the specification provides insufficient guidance as to which of the essentially infinite possible choices is likely to be successful.

Thus, applicants have not provided sufficient guidance to enable one of ordinary skill in the art to make and use the claimed invention in a manner reasonably correlated with the scope of the claims broadly including exonuclease with an enormous number of amino acid modifications of the exonuclease of SEQ ID NO:2. The scope of the claims must bear a reasonable correlation with the scope of enablement (*In re Fisher*, 166 USPQ 19 24 (CCPA 1970)). Without sufficient guidance, determination of exonucleases having the desired biological characteristics is unpredictable and the experimentation left to those skilled in the art is unnecessarily, and improperly,

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extensive and undue. See *In re Wands* 858 F.2d 731, 8 USPQ2nd 1400 (Fed. Cir, 1988).

In response to the previous Office Action, applicants have traversed the above rejection. Applicants argue that the specification teaches the structure of variants and fragments of MRE11 and therefore a person skilled in the art has sufficient guidance in making a polypeptide comprising 90 contiguous amino acids of SEQ ID NO:2 or polypeptides comprising at least 80%-95% identity to SEQ ID NO:2. Examiner respectfully disagrees. Predictability of which changes can be tolerated in a protein's amino acid sequence and obtain the desired activity requires a specific knowledge of and guidance with regard to which specific amino acids in the protein's sequence, can be modified such that the modified polypeptide continues to have said claimed activity. It is this specific guidance that applicants do not provide. Without specific guidance, those skilled in the art will be subjected to undue experimentation of making and testing each of the enormously large number of mutants and fragments of SEQ ID NO:2 that results from such experimentation. While the art may teach in general the structure of MRE11 having exonuclease activity, conserved amino acid sequences, and etc, such teachings will not reduce the burden of undue experimentation on those of ordinary skill in the art. Hence the rejection is maintained.

Claims 6 and 8 are allowed.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

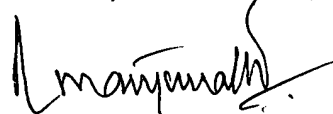
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 571-272-0935. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Yong D. Pak
Patent Examiner 1652



Rao Manjunath
Primary Patent Examiner 1652